



DOCKET NO.: 202887US-2

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: U.S. Application
Serial No: 09/778,104
Filed: FEBRUARY 7, 2001
Group: 2826
Inventor: YUICHI HIRANO, ET AL.
For: SEMICONDUCTOR DEVICE AND
METHOD OF MANUFACTURING SAME



ATTORNEYS AT LAW
GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM
ECKHARD H. KUESTERS
(703) 413-3000
EKUESTERS@OBLON.COM

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$ --0-- is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Registration No. 25,599
Eckhard H. Kuesters
Attorneys of Record
Registration No. 28,870



22850

Tel: (703) 413-3000
Fax No: (703) 413-2220
GJM:EHK:RAR:clh

RECEIVED
OCT 30 2002
TECHNOLOGY CENTER 2800

202887US-2



#7
Electronics
10/30/02
CJS

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

:

Yuuichi HIRANO, et al.

: GROUP ART UNIT: 2826

SERIAL NO.: 09/778,104

:

FILED: February 7, 2001

: EXAMINER: Mandala, V.

FOR: SEMICONDUCTOR DEVICE AND METHOD FOR MANUFACTURING SAME

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS

WASHINGTON, D.C. 20231

SIR:

In response to the Election of Species Requirement dated September 27, 2002, Applicants elect Species I, described in Figures 1-13, corresponding to Claims 1, 2, 5, and 6. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Election Requirement for the reason that the inventions of Species I-VIII, indicated in the Election of Species Requirement, have not been shown to be distinct in the manner required by M.P.E.P. §816. MPEP §816 states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

Since the Election Requirement fails to set forth reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct, it cannot be said to have met the requirement of MPEP §816.

In addition MPEP §806.04(f) requires:

RECEIVED
OCT 30 2002
TECHNOLOGY CENTER-2800

...Claims to be restricted to different species must be mutually exclusive...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics. This provides additional basis for traversing the election of species requirement.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on Applicants to be required to file, prosecute and maintain separate applications and patents on the identified.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-13 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Eckhard H. Kuesters
Registration No: 28,870
Attorneys of Record



22850

Tel. No.: (703) 413-3000
Fax No.: (703) 413-2220
GJM:EHK:RAR:clh/jrs
I:\atty\RAR\restrictions\202887US\elect.wpd